

REMARKS

Reconsideration of the pending application is respectfully requested on the basis of the following particulars.

1. In the claims

As shown in the foregoing LIST OF CURRENT CLAIMS, the claims have been amended to more clearly point out the subject matter for which protection is sought.

Claim 1 is amended to clarify that the method includes the step of checking the bank notes with comparative data stored by the bank note processing machine and derived from authentic bank notes and known forgeries, wherein the comparative data is produced by capturing features selected from the group consisting of printing inks with special optical and/or magnetic properties, metallic or magnetic security threads, paper used for the bank notes being free of brighteners, information contained in an electrical circuit, bank note size, printing pattern, colors, optical appearance, and combinations thereof.

Similarly, claim 6 is amended to clarify that the comparative data is produced by capturing features selected from the group consisting of printing inks with special optical and/or magnetic properties, metallic or magnetic security threads, paper used for the bank notes being free of brighteners, information contained in an electrical circuit, bank note size, printing pattern, colors, optical appearance, and combinations thereof.

Additionally, new claim 8 is added, and mirrors previous claim 1, with the clarification that the comparative data is produced by capturing features related to physical properties of bank notes.

It is respectfully submitted that no new matter is added, since support for the amendments may be found, for example, at least in paragraphs [0011] and [0013] of the accompanying description in the specification as originally filed.

Claims 2-5 and 7 are left unchanged.

Entry of the LIST OF CURRENT CLAIMS is respectfully requested in the next Office communication.

2. Rejection of claims 1-3 and 5-7 under 35 U.S.C. § 103(a) as being unpatentable over U.S. publication no. US 2003/0132281 (*Jones et al.*) in view of Japanese publication no. 2001-157044 (*Murata et al.*)

Reconsideration of this rejection is respectfully requested on the basis that the rejection fails to establish a *prima facie* case of obviousness with respect to amended claims 1 and 6. The remaining claims depend from amended claim 1 or 6, and are therefore patentable as containing all of the recited steps of amended claim 1 or features of amended claim 6, as well as for their respective recited features.

By way of review, amended claims 1 and 6 recite that the comparative data is produced by capturing features selected from the group consisting of printing inks with special optical and/or magnetic properties, metallic or magnetic security threads, paper used for the bank notes being free of brighteners, information contained in an electrical circuit, bank note size, printing pattern, colors, optical appearance, and combinations thereof.

Turning to the *Jones* publication, it is respectfully submitted that the *Jones* publication does not disclose the use of comparative data derived from authentic bank notes and known forgeries and the use of additional comparative data relating to new types of forgeries in order to check processed bank notes to determine whether a forged bank note is present, wherein the comparative data is produced by capturing features selected from the group consisting of printing inks with special optical and/or magnetic properties, metallic or magnetic security threads, paper used for the bank notes being free of brighteners, information contained in an electrical circuit, bank note size, printing pattern, colors, optical appearance, and combinations thereof, as required by amended claims 1 and 6.

The comments presented in the Appeal Brief dated December 9, 2009 and the responses filed June 10, 2010, and December 2, 2010 are hereby incorporated by reference.

In particular, the *Jones* publication only teaches the use of comparative data derived from authentic bank notes and from *known* forgeries in order to detect counterfeit bank notes. As can be seen, while the *Jones* publication discloses updating a database with serial numbers associated with bills determined to be counterfeit when compared against existing comparative data derived from authentic bank notes and from *known* forgeries (paragraphs [0093], [0142], [0143], [0148], [0182]-[0187]), these updated serial numbers are only associated with forgeries or counterfeit documents that are recognized based upon the *known* comparative data derived from authentic documents and known forgeries, and cannot be considered to be additional comparative data for *new* types of forgeries, which are not recognized based upon the *existing* comparative data derived from authentic bank notes and known forgeries, as is required by amended claims 1 and 6.

Additionally, since serial numbers are not any of printing inks with special optical and/or magnetic properties, metallic or magnetic security threads, paper used for the bank notes being free of brighteners, information contained in an electrical circuit, bank note size, printing pattern, colors, optical appearance, and combinations thereof, the fact that the *Jones* publication updates a database with serial numbers of existing counterfeits, and then compares serial numbers of additional bills to the serial numbers in the updated database does not disclose or suggest every feature of amended claims 1 and 6.

Thus, while the *Jones* publication discloses the use of an updated serial number database, since the serial numbers are only affiliated with documents determined to be forgeries based upon known forgeries, and serial numbers are not any of printing inks with special optical and/or magnetic properties, metallic or magnetic security threads, paper used for the bank notes being free of brighteners, information contained in an electrical circuit, bank note size, printing pattern, colors, optical appearance, and combinations thereof, it can be seen that the *Jones* publication simply fails to disclose the

use of additional comparative data derived from new types of forgeries, which are not recognized based upon the comparative data derived from authentic banknotes and known forgeries, as is required by both amended claim 1 and amended claim 6.

The system according to the *Jones* publication is thus similar to the types of systems discussed in the Background of the pending application wherein new forgeries are not recognized and are thus erroneously judged as an authentic bank note (specification at [0002]-[0004]). In other words, the system according to the *Jones* publication is simply incapable of recognizing new types of forgeries.

This deficiency of the *Jones* publication is acknowledged in the Office action on page 5 (“Jones fails to specifically teach “[sic] provide the comparative data derived from authentic bank notes and known forgeries and the additional comparative data for new types of forgeries that may have arisen after the comparative data derived from authentic bank notes and known forgeries was established.”)

The Office action on page 5 turns to the *Murata* publication in an attempt to cure the deficiencies of the *Jones* publication. However, it is respectfully submitted that the *Murata* publication does not provide for the shortcomings of the *Jones* publication, for the reasons discussed in the response filed December 2, 2010, where a copy of a machine translation of the *Murata* publication is attached in Appendix A, and all previous and current references refer to the machine translation of the *Murata* publication, unless otherwise noted.

The *Murata* publication relates to the concept that it is desirable to prevent color copiers or facsimile machines from creating duplicate images of authentic documents (bank notes and securities) that are in existence when the copier or facsimile machine is manufactured, as well as authentic documents that are newly issued after the copier or facsimile machine is manufactured (Derwent-ACC-No: 2001-448475, abstract; paragraphs [0001], [0004], [0009], [0014], [0020], [0021], [0029], [0031]).

In particular, the copier of the *Murata* publication has ROM (fixed characteristics storages parts store 5) that stores information relating to authentic bills/securities that are in existence when the copier is manufactured (paragraph [0014]).

The copier of the *Murata* publication also has a registration mode, in which information regarding newly issued authentic bills/securities can be registered in the copier and stored in the registration characteristic storage section 4 (paragraphs [0020], [0024]).

Further, the copier of the *Murata* publication has a “usual copy” mode, in which a document to be copied is scanned, the scanned image is compared against the data in the fixed characteristics storages parts store 5 and the registration characteristic storage section 4 in order to judge whether the document to be copied is the same as an authentic bill that was circulating when the copier was manufactured or whether the document to be copied is the same as an authentic bill that was issued after the copier was manufactured, and registered in the copier (paragraphs [0021], and [0026] through [0028]).

If a document to be copied is determined to be the same as an existing authentic bill or subsequently registered authentic bill, than the copier will consider the situation to be a “coincidence” and will print the copy with some portion of the object image affected so as to not produce an exact copy (paragraphs [0027], [0028]). If the document to be copied is not determined to be the same as an existing authentic bill or subsequently registered authentic bill, than the copier will print a copy of the document to be copied (paragraph [0028]).

Thus, while the copier of the *Murata* publication compares a document to be copied against information relating to existing authentic bills in circulation when the copier is manufactured, and against information relating to newly issued authentic bills that have been subsequently registered in the copier, all of the information that is retained in the copier relates to *authentic* bills, and does not relate to information on new types of *forgeries*.

Thus, similar to the *Jones* publication, the *Murata* publication also fails to disclose the use of comparative data derived from authentic bank notes and known forgeries and the use of additional comparative data relating to new types of forgeries in order to check processed bank notes to determine whether a forged bank note is present, wherein the comparative data is produced by capturing features selected from the group consisting of printing inks with special optical and/or magnetic properties, metallic or magnetic security threads, paper used for the bank notes being free of brighteners, information contained in an electrical circuit, bank note size, printing pattern, colors, optical appearance, and combinations thereof, as required by amended claims 1 and 6.

Therefore, even if the teachings of the *Murata* publication, which relate to a copier/facsimile device, were utilized to modify the document processing system of the *Jones* publication, it is respectfully submitted that the proposed combination of the *Jones* and *Murata* publications would still fail to disclose the use of comparative data derived from authentic bank notes and known forgeries and the use of additional comparative data relating to new types of forgeries in order to check processed bank notes to determine whether a forged bank note is present, wherein the comparative data is produced by capturing features selected from the group consisting of printing inks with special optical and/or magnetic properties, metallic or magnetic security threads, paper used for the bank notes being free of brighteners, information contained in an electrical circuit, bank note size, printing pattern, colors, optical appearance, and combinations thereof, as required by amended claims 1 and 6.

Accordingly, since the proposed combination of the *Jones* and *Murata* publications fails to disclose all of the features required by amended claims 1 and 6 a *prima facie* case of obviousness cannot be established with respect to amended claims 1 and 6, and withdrawal of this rejection is respectfully requested.

Claims 2-3, 5, and 7 are allowable for all the reasons given above concerning base claim 1 or 6, and further in view of their specific recitations. Accordingly, since the proposed combination of the references fails to disclose all of the features required by amended claims 1 and 6, a *prima facie* case of obviousness cannot be established with

respect to amended claims 1 or 6, from which claims 2-3, 5, and 7 respectively depend. Therefore, withdrawal of this rejection is respectfully requested.

3. Rejection of claim 4 under 35 U.S.C. § 103(a) as being unpatentable over U.S. publication no. US 2003/0132281 (*Jones et al*) in view of Japanese publication no. 2001-157044 (*Murata et al.*) and further in view of European publication no. EP 1 255 232 (*Pernot et al.*)

Reconsideration of this rejection is respectfully requested on the basis that the rejection fails to establish a *prima facie* case of obviousness with respect to amended claim 1, from which claim 4 depends, on the basis that the *Pernot* patent fails to provide for the deficiencies of the *Jones* and *Murata* publications as discussed above in detail with respect to amended claim 1.

Accordingly, withdrawal of this rejection is respectfully requested.

4. New claim 8

New claim 8 mirrors previous claim 1, with the clarification that the comparative data is produced by capturing features related to physical properties of bank notes.

As discussed above, while the *Jones* publication discloses updating a database of serial numbers with new serial numbers of suspected counterfeit bills, a serial number is not a physical property of a bank note. Thus, for the same reasons as discussed in detail above, it is respectfully submitted that new claim 8 is considered to be patentable over the proposed combination of the *Jones* and *Murata* publications.

5. Conclusion

As a result of the amendment to the claims, and further in view of the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is respectfully requested that every pending claim in the present application be allowed and the application be passed to issue.

Please charge any additional fees required or credit any overpayments in connection with this paper to Deposit Account No. 02-0200.

If any issues remain that may be resolved by a telephone or facsimile communication with the applicants' attorney, the examiner is invited to contact the undersigned at the numbers shown below.

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Respectfully submitted,

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